

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S) : Hayes, et al.

TITLE : **CONFIGURABLE BILLING SYSTEM  
SUPPORTING MULTIPLE PRINTER  
PRODUCTS AND BILLING SYSTEMS**

APPLICATION NO. : 09/750,603

FILED : December 28, 2000

CONFIRMATION NO. : 6753

EXAMINER : Stefanos Karmis

ART UNIT : 3691

LAST OFFICE ACTION : August 8, 2006

ATTORNEY DOCKET NO. : Docket No.: 99181-US-NP  
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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Applicants respectfully submit the following 5 pages including reasons for requesting a Pre-Appeal Review of the above-captioned matter.

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### **The Present Application**

As indicated, for example, in Applicants' Response D, which was mailed May 26, 2006, on pages 2 and 3, the present application is directed toward a configurable billing module that can support, by virtue of its configurability, a wide variety of machines and systems. For example, the billing module can support or perform accounting functions for a variety of document processing systems. For instance, the billing module accepts a billing strategy from an associated document processing system. The billing strategy lists parameters, events, or aspects of interest that the billing module is to monitor. Additionally, the billing strategy provides algorithms that define the function of billing meters. The billing module can instantiate and/or update the meters based on the monitored parameters or aspects of interest as indicated by the billing strategy. The list of aspects of interest and the list of meter descriptions may be arbitrarily long. The ability of the billing module to receive and interpret arbitrary or custom billing strategies allows the billing module (or the software associated with the billing module) to be reused in a wide variety of applications. Device developers need only define the billing strategy, therefore, the need to "hard code" custom billing software for each new device is eliminated. (Abstract, page 1, lines 13-17, page 6, lines 1-3, lines 13-17, page 7, lines 25-26, page 9, lines 14-29).

**The ability to accept and process arbitrarily long billing strategies differentiates the claimed subject matter from the subject matter discussed in the cited references.** For example, **claim 1** recites:

A configurable billing system for a machine, the machine operative to output a product or service and including a plurality of aspect sensors, the sensors operative to detect the delivery of aspects of the product or service and to report the delivery to the billing system, the billing system comprising:

a coded billing strategy **including an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions** defined for the machine; and

a plurality of meters updated by the billing system for recording the delivery of the aspects of the product or service based on the billing strategy, whereby the billing system tallies the aspects in a manner defined in the billing strategy.

Independent **claim 6** recites *inter alia*: a billing strategy description, **including an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions**, accessible by the billing system.

Independent **claim 16** recites *inter alia*: a configurable billing system operative to follow a billing strategy specification **including an arbitrarily long list of document production events of interest, an arbitrarily long list of meter descriptions** and a machine readable script for updating the meters defined in the list to record the occurrence of document production events as described in the billing strategy specification.

Independent **claim 20** recites *inter alia*: a custom billing strategy file including an **arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions** defined for the machine.

Independent **claim 23** recites *inter alia*: a billing strategy file defining a billing strategy in machine readable form, the billing strategy file **describing an arbitrarily large number of mathematical functions of an arbitrarily large number of meters** for processing and recording information reported by the at least one aspect sensor;

a billing module operative to receive the billing strategy file and instantiate the **arbitrarily large number of meters** according to the billing strategy.

It is the position of the Office Actions that the phrases highlighted above that include the word "arbitrarily" are indefinite in the sense of 35 U.S.C. §112, second paragraph, and **claims 1-18, 20 and 23** stand rejected on that basis. It is respectfully submitted that this represents a **clear error of the Office Actions** and Pre-Appeal Review is respectfully requested.

Additionally, the Office Actions appear to give no patentable weight to the phrases highlighted above which include the word "arbitrarily." It is respectfully submitted that this represents a **clear error** of the Office Actions. Accordingly, the rejections of **claims 1-7, 16, 17 and 19-23** under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,516,157 to Maruta, et al. ("Maruta") and the rejections of **claims 8-15 and 18** under 35 U.S.C. §103(a) as being unpatentable over Maruta are **based on clear error** and Pre-Appeal Review is respectfully requested.

Pages 4 and 5 of Applicants' Response D, which was mailed May 26, 2006, and which presents definitions of the word --arbitrarily-- and the word --arbitrary-- and an Internet Encyclopedia "Wikipedia" article regarding the phrase --arbitrarily large--.

Applicants' Response D also points out, on page 5, that the acceptability of claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification (MPEP 2173.05(b)). It is respectfully submitted that one of ordinary skill in the art would understand the meaning of the phrases highlighted above in light the specification or from common knowledge related to the definitions and article. With regard to the specification, see, for example, page 6, line 11 - page 9, line 28, and, in particular, page 6, line 13 and page 7, pages 25-26.

The Final Office Action mailed August 8, 2006 asserts that the arguments identified above are not persuasive (see page 3). It is respectfully submitted that this represents a **clear error** of the Office Actions and Pre-Appeal Review is respectfully requested.

In further support of the assertion that one of ordinary skill in the art would understand the meaning of the phrase --arbitrarily long--, the Applicants identified 20 U.S. patents including 29 claims that include the phrase --arbitrarily long-- (see the middle of page 7 - page 9 of Applicants' Amendment E, which was mailed September 25, 2006). Pre-Appeal Review is requested.

Applicants' Amendment E was refused entry because Amendment E included an amendment to **claim 22** to recite "a set of meters for recording occurrences of document production events" and this amendment allegedly raised new issues. However, it is respectfully submitted that this assertion represents a **clear error** of the Office Actions. This clarifying amendment to **claim 22** should not have raised new issues. For example, the preamble to **claim 6** recites a plurality of aspects sensors operative to detect **document production events** and to report the aspects of the document production to the billing system. Additionally, **claim 21** recites a configurable billing system for a document processing system, the document processing system including *inter alia*: one or more aspect sensor operative to **detect document production events** and to **report the document production events** to the billing system. Accordingly, it is respectfully submitted an amendment to **claim 22** adding the word --events-- so that **claim 22**, as indicated above, should not have raised new issues.

For at least the foregoing reasons, it is respectfully submitted that the refusal of entry of Applicants' Amendment E **represents a clear error of the Office Actions** and Pre-Appeal Review is respectfully requested.

After a telephone conference with the Examiner, the Applicants prepared and filed Applicants Amendment F, which is similar to Applicants' Amendment E, except that Amendment F does not include the amendment to claim 22. Accordingly, Amendment F was entered. However, on January 12, 2007, a new or second Advisory Action was mailed.

The second Advisory Action acknowledges the numerous examples provided by the Applicant of the term --arbitrarily-- being found in patent claims. However, the Advisory Action asserts that this is not the test for determining whether one of ordinary skill in the art would understand how the term is being used in the claim language. In this regard, it is respectfully submitted that the list provided by the Applicants in Amendment E, and again in Amendment F (see page 7, last line - page 10, first paragraph) provides clear and convincing evidence that one's (e.g., the associated examiners and inventors) of skill in the technical arts would and do understand the meaning of the phrase --arbitrarily long--. Accordingly, the indication of the second advisory action that the phrase --arbitrarily long-- is indefinite represents a **clear error** of the Office Actions and Pre-Appeal Review is respectfully requested.

The second Advisory Action goes on to indicate that in claim 1, having an "arbitrarily long list" renders the claim indefinite because it is not clear what is considered to be arbitrary. However, it is respectfully submitted that one of ordinary skill in the art would understand that it is the length of the list that is arbitrarily long. Accordingly, it is respectfully submitted that these additional statements represent a **clear error** of the second Advisory Action and Pre-Appeal Review is respectfully requested.

With regard to Maruta, the second Advisory Action acknowledges the argument of the Applicants that Maruta fails to teach "a configurable billing system", but indicates that the Examiner respectfully disagrees. The Advisory Action asserts that while the Applicants claim in the preamble that the system is configurable, there is no configuring done in claim 1. The

Advisory Action goes on to assert that there is no link in the body of the claim tied to the preamble. Simply because the body of the claim has a billing strategy does not mean that it is configurable.

However, it is respectfully submitted that the configurability referred to in the preamble of claim 1 stems from the fact that the coded billing strategy includes an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions defined for the machine and that the configurable billing system includes a plurality of meters updated by the billing system for recording the delivery of aspects of the product or service based on the billing strategy, whereby the billing system tallies the aspects in a manner defined in the billing strategy.

Moreover, even if the assertions of the second Advisory Action with regard to a link in the body of the claim tied to the configurability recited in the preamble are fairly applied to **claim 1** (which is disputed), similar reasoning is not applicable to, for example, claim 16 which recites a document processing system comprising *inter alia* "a **configurable** billing system in the body of the claim. Additionally, as explained, for example, beginning below the middle of page 11 - the middle of page 12 of Applicants' Amendment F, it is respectfully submitted that Maruta discloses a system fixed with four counters (column 9, lines 25-31). The billing system of Maruta is not configurable. Additionally, Maruta does not disclose or suggest a billing strategy specification including an arbitrarily long list of document production events of interest or an arbitrarily long list of meter descriptions such as those included in the recitation of the configurable billing system of **claim 16**. Similar arguments are applicable to **claim 22**.

For at least the foregoing reasons, the rejection of **claim 16** as being anticipated by Maruta **represents a clear error** of the Office Actions and Pre-Appeal Review is respectfully requested.

Further in this regard, it is noted that the Final Office Action explains the rejections of **claims 6, 16, 19 and 20-22** simply by asserting that **claims 6, 16, 19 and 20-22** are substantially similar to claim 1 and remain rejected for similar reasons as stated above [i.e., with regard to claim 1]. As indicated above, it is respectfully submitted that **claim 16** is not similar to claim 1, at least in that **claim 16** clearly includes the link to configurability that the second Advisory Action asserts is needed and missing from claim 1. Accordingly, the rejection of **claim 16** **represents a clear error** of the Office Actions and Pre-Appeal Review is respectfully requested.

**Clear errors** of the Office Actions related to the rejection of **claim 19** are identified in the bottom portion of page 12 of Applicants' Amendment F. Maruta does not disclose or suggest a machine-readable script or a machine-readable script including a billing strategy specification as recited in claim 19. For at least these reasons and the other reasons provided in Applicants' Amendment F, claim 19 is not anticipated by Maruta and the rejection of claim 19 represents a clear error of the Office Actions.

**Clear errors** of the Office Actions related to the rejection of **claim 20** are discussed beginning at the bottom of page 12 - the middle of page 13 of Applicants' Amendment F. Pre-Appeal Review is respectfully requested.

**Clear errors** of the Office Actions related to the rejection of **claim 21** are identified in the bottom half of page 13 of Applicants' Amendment F. Pre-Appeal Review is respectfully requested.

**Errors** of the Office Actions related to the rejections of **claims 22** are discussed beginning at the bottom of page 13 - most of page 14 of Amendment F. It is respectfully submitted that Maruta does not disclose or suggest a machine-readable script received in a billing strategy file.

Additionally, as noted above, **claim 22** recites a configurable billing system in the body of the claim. Even if the Office were justified in not giving the phrase --configurable billing system-- patentable weight claim 1 (which is disputed), it is respectfully submitted that the phrase --configurable billing system-- must be given patentable weight in **claim 22**.

For at least the foregoing reasons, it is respectfully submitted that the rejections of **claim 22** represent **clear errors** of the Office Actions and Pre-Appeal Review is respectfully requested.

Discussion of the **clear errors** of the Office Actions with regard to **claim 23** can be found, for example, beginning near the bottom of page 14 - top portion of page 16 of Applicants' Amendment F. Discussion of the **clear errors** of the Office Actions related to dependent **claims 2, 3, 4, 5 and 7** can be found, for example, on page 16 of Applicants' Amendment F. Discussion of the **clear errors** of the Office Actions related to **claims 8-15 and 18** can be found at the top of page 17 of Applicants' Amendment F and Pre-Appeal Review is respectfully requested.

Additional discussion of errors of the Office Actions can be found in Applicants' Response D, which was mailed May 26, 2006. General comments related to Maruta and its deficiencies with regard to disclosure or suggestion of the elements of the claims of the present application can be found on pages 3 and 4. **Errors** of the Office Actions with regard to definiteness can be found on pages 4 and 5. **Errors** of the Office Actions regarding rejections related to anticipation by Maruta begin at the bottom of page 5 - the middle of page 10. The **errors** of the Office Actions regarding obviousness rejections are addressed in the bottom portion of page 10.

For at least the foregoing reasons, Pre-Appeal Brief Review is requested.

Respectfully submitted,

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Date